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09/234,559 01/20/99 RAMAKESAVAN

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EXAMINER

KOSTAK, V

ART UNIT

PAPER NUMBER

2711

DATE MAILED:

07/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/234,559

Applicant(s)

Ramakesavan

Examiner

Victor R. Kostak

Group Art Unit

2711



☒ Responsive to communication(s) filed on Jun 26, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 and new claims 21-26 are all now rejected under 35 U.S.C. 103(a) as being unpatentable over Russo (of record), in view of applicant's amendment.

Reviewing Russo (Fig. 2), he arranges a video-on-demand system which involves billing, wherein the programs which are user-selected are stored at the user's station. A storage medium 110 and a decrypting engine (descrambling element 114) are included, and the program reproduction is carried out using various user interfaces which access a controller 150 by a control bus 154 and a data bus 152.

To circumvent Russo, applicant now recites a pause feature which is accessed using the system controller. However, Russo clearly suggests such a feature, whereby he accounts for the situation where if the viewer cannot finish a program for viewing once it has been selected, the system will keep track of where the user left off and pick up at that point (col. 11 lines 14-17), which essentially describes a pause-type condition. In view of this explicitly described alternative embodiment, it would therefore have been obvious to consider such a feature as a pause function, whereby the controller 150 would recognize this command by an inherent code, as a separate command from a resume or play command, thereby meeting claims 1 and 14 (it is noted that claim

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14 does not recite decrypting, and in fact essentially defines video-on-demand, as pointed out in the last Office action).

As for claim 2, the controller is directly associated with many various processing devices.

As for claim 3, the descrambling device carries out its process when the user requests a program to be shown, as would be expected.

Regarding claims 4 and 10, the transmission end is inherent in the system of Russo or else the communication to the receiving end would be impossible. The transmitting station inherently distributes programs to plural subscribers upon request, and would include decrypting data sent in a controlled manner (since the receiver includes circuitry for carrying out the decrypting). The pause feature has been described above.

As for claim 5, user ID information (such as a unique subscriber address) is also inherent for the clear purpose of providing the requested programming and the associated decrypting data to each individual user on command. A descrambling code is prompted by a debit (col. 10 lines 25-31).

Concerning claim 6, the inherent controller is part of the transmitting arrangement, as are other components.

As for claims 7 and 8, Russo uses a cable medium (note Fig. 1) and mentions satellite as well (col. 6 lines 16-17).

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As for claim 9, the user makes requests from the receiver side for specific selections from the database of programs stored at the transmitting end based on program ID data, such as the title, as is typical. Russo discusses such in col. 10 lines 1-19, for example.

Regarding claim 13, the descrambling authorization is accordingly sent to the receiver which requested the program based on the receiver ID (e.g. addresses). The pause feature has been described above..

As for claim 15, Russo points out that the controller can be associated with any type of user interface (col. 4 lines 5-14), such as a keyboard, integrated CRT displays, touch screen accessories, and others.

As for claims 16 and 17, controller 150, which is a microcomputer (col. 9 lines 34-42) controls the other processors including access to the scrambled downloaded video data, according to various instructions stored on an inherent medium, as is typical of microcomputers. The pause feature has been described above.

Considering claim 20, the receiving end of Russo inherently includes ID data, typically a subscriber address, which is processed by instructions stored by the system.

Regarding claims 11, 12, 18 and 19, as mentioned above, the descrambling code is triggered by a debit signal , and it would have been obvious to send the code access either from the same video source or a separate source, either way being inconsequential.

As for new claims 21-26, they all essentially recite a resume mode, which would naturally be applied when the pause function is removed. As discussed above, Russo resumes play when

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the pause-type feature is removed, and in col. 11 lines 17-20 he says that the system will pick up where the user left off without an additional charge (thus ensuring that the user is not charged twice). This would naturally be done by prompting the controller 150 with the specific resume or play command codes.

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is (703) 305-4374. The examiner can normally be reached on Monday - Friday from 6:30am - 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306, (for formal communications; please mark "EXPEDITED PROCEDURE"; for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

**Victor R. Kostak
Primary Examiner**

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VRK

July 21, 2000

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